

PRE-APPEAL BRIEF REQUEST FOR REVIEW	Docket Number (Optional) 059643.00361
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed Name _____	Application Number: 10/762,531 Filed: January 23, 2004 First Named Inventor: Tony HULKKONEN et al. Art Unit: 2617 Examiner: D'Agosta, Stephen M.

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

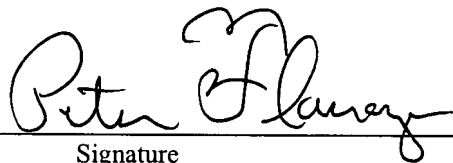
I am the

- ☐ Applicant/Inventor.
- ☐ assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed

- ☒ Attorney or agent of record.
Registration No. 58,178

- ☐ Attorney or agent acting under 37 CFR 1.34.
Reg. No. is acting under 37 CFR 1.34 _____


Signature

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July 3, 2007
Date

NOTE: Signatures of all of the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

- ☐ *Total of _____ forms are submitted.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Confirmation No.: 5351

Tony HULKKONEN et al.

Art Unit: 2617

Application No.: 10/762,531

Examiner: D'Agosta, Stephen M.

Filed: January 23, 2004

Attorney Dkt. No.: 059643.00361

For: EMERGENCY CALL SUPPORT FOR MOBILE COMMUNICATIONS

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

July 3, 2007

Sir:

In accordance with the Pre-Appeal Brief Conference Pilot Program guidelines set forth in the July 12, 2005 Official Gazette Notice, Applicants hereby submit this Pre-Appeal Brief Request for Review of the final rejections of claims 1-47 in the above identified application. Claims 1-47 were finally rejected in the Office Action dated February 9, 2007. Applicants filed a Response to the Final Office Action on April 9, 2007, and the Office issued an Advisory Action dated April 25, 2007, maintaining the final rejections of claims 1-47. Applicants hereby appeal these rejections and submit this Pre-Appeal Brief Request for Review.

Clear Error – Admittedly Erroneous Rejection Maintained

A first clear error in the rejection is with respect to the rejection of claims 9 and 13 for lack of novelty. It is respectfully submitted that, as the Advisory Action admitted, claims 9 and 13 contain novel material. Accordingly, it is respectfully submitted that it is clear error to maintain the rejection of claims 9 and 13 for lack of novelty.

Clear Error – Combination of References Cited in Anticipation Rejection

A second clear error in the rejection is with respect to the alleged teaching of the combination of Lindgren with Sagers and/or Kowaguchi. It is clear, and the Advisory Action admitted, that Lindgren by itself is insufficient to teach the present invention as recited, for example, in claim 1. The Office Action took the position that the deficiencies of Lindgren are

solved by the teachings of Sagers and/or Kowaguchi and the combination is obvious. Nevertheless, claims 1-42 and 45-47 were rejected as anticipated on page 3 of the Office Action. This rejection is clear legal error.

Clear Error – Critical and Non-Obvious Advantages Stand Unaddressed

A third clear error of the Final Rejection was the failure of the Office Action to address the critical and unobvious advantages of the present invention. As described in the background section of the present application's specification, previous techniques of handling an emergency call can lead to an emergency call being dropped. In the previous techniques, an emergency call is established without "network access information" (as recited in the claims) being requested and/or received at a controlling network element. Consequently, the established emergency call may be dropped if this "network access information" is subsequently received at a network element. This might occur if the user equipment attempted to establish an additional connection during the emergency call. (It should be noted that the call would only typically be dropped if the "network access information" specifies that the user equipment is not allowed access).

Certain embodiments of the present invention solve this problem, in particular by "receiving, at the network element, network access information relating to said user equipment, said network access information indicating the areas the user equipment is allowed to access; selectively controlling access to the network in dependence on said network access information; and disabling the step of selectively controlling access to the network for an emergency call network access," as recited in claim 1. Thus, certain embodiments of the present invention provide critical and unobvious advantages over the cited art and previous techniques.

There is no identification of any such problem in Lindgren (or any of the other cited references). Consequently, there is no motivation to make any modification of Lindgren to arrive at the present invention as recited in the presently pending claims. It is, therefore, respectfully submitted that the present invention is non-obvious for this reason alone. The Office Action's failure to address the critical and unobvious advantages is clear legal error that warrants reversal of the rejection.

Clear Error – No Teaching, Motivation, Suggestion or Other Reason to Combine the References

Furthermore, the above argument notwithstanding, should the skilled person be somehow inspired to attempt to remedy the deficiencies of Lindgren, this skilled person would not find reason to look to the teachings of Sagers and/or Kowaguchi. In other words, the rejection is deficient with respect to teaching, motivation, suggestion, or other reason to combine the reference. This is clear legal error as well.

Lindgren discusses a technique for allowing a cellular phone to access a network in an emergency, the determining being done at an element in the network. In contrast, Sagers/Kowaguchi discuss a technique for preventing transmissions by a portable radio located in a “hazard area,” the determining being done by the radio itself.

The substantial differences in the teachings of the two set of documents regarding the determining entity, the reasons for the determination, and the effect of that determination, unmistakably prove that combining the documents is, in itself, non-obvious. The only motivation, therefore, that might be found to combine the documents is in the present application and consequently the Examiner’s statements can only constitute an impermissible form of hindsight analysis. This is clear legal/factual error that requires reversal of the rejection.

Clear Error- Rejection Fails to Address Each and Every Claim Limitation

Moreover, as will be demonstrated below, the Office Action’s rejection fails to deal with specific recitations of the claims, and cites art directed toward a perceived summary of the claimed subject matter. This is clear legal error, because the rejection must address each and every element of the claimed invention, not a paraphrased summarization of the invention.

Clear Error – Phrases in Claim Treated in Isolation

Additionally, the Office Action took the position that isolated features of the claims are found in one or other of the two sets of prior art documents. The teachings of Sagers/Kowaguchi are cited as “disabling mobile devices based on the device’s location.” From the Examiner’s previous arguments and the deficiencies of the alleged teaching of Lindgren, it is evident that the Office Action is attempting to use this feature to teach, at the very least, “information indicating the areas the user equipment is allowed to access.”

Information determining the disabling (of the transmitter) of a mobile station (by the mobile station) cannot correspond to information that determines access to a network. Consequently, the feature “information indicating the areas the user equipment is allowed to access” cannot possibly be found in any of the cited references. Therefore, irrespective of the previous points, a combination of the prior art documents is still unable to teach the present invention. Accordingly, the Office Action’s assertion to the contrary constitutes clear factual error that mandates reversal.

Clear Error – The Combination of Cited Teachings would not Yield Claims

With all the above arguments notwithstanding, and in particular making the assumption (not admitted) that Sagers and/or Kowaguchi teaches “information indicating the areas the user equipment is allowed to access,” the cited references are still unable to teach what is recited in the claims. The method of claim 1 comprises the unified feature of “receiving, at the network element, network access information relating to said user equipment, said network access information indicating the areas the user equipment is allowed to access.”

This feature, to be taught, requires that “network access information indicating the areas the user equipment is allowed to access” is itself received at a network element. The Office Action asserted that Lindgren teaches “receiving network access information relating to said user equipment.” Examples of this information are given in Lindgren and are an ESN, or phone number. There is no hint or suggestion that this might be “information indicating the areas the user equipment is allowed to access.” In other words, Lindgren simply teaches receiving information, not the recited “network access information.”

Even by allowing the above assumption about the teachings of Sagers/Kowaguchi to be made, there is no hint or suggestion that this information (information indicating the areas the user equipment is allowed to access) is sent to a network element. In other words, Sagers and/or Kowaguchi can only teach the existence of a certain type of information (which is stored in and used by a “location determining device” within the mobile radio).

Therefore, the only way the above-identified unified feature of claim 1 might be taught (even with the above assumption) is if disparate features of two prior art documents are mosaiced together. Since there is no logical reason to do this, other than an attempt to teach the claim phrase by phrase, it is yet again submitted that the combination of features in claim 1 is non-

obvious over the prior art, and that the rejection of, for example, claim 1 constitutes clear factual/legal error.

Clear Error – Failure to Answer All Arguments Presented / Non-Responsive

The above-identified errors in the rejection stand without substantial rebuttal in the record. Accordingly, a final legal error in the rejection is the failure of the Office Action to fully respond to the distinctions raised.

Reconsideration and withdrawal of the rejections, in view of the clear errors in the Office Action, is respectfully requested. In the event this paper is not being timely filed, Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Peter Flanagan", written over a horizontal line.

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Enclosures: PTO/SB/33 Form
Notice of Appeal
Petition for Extension of Time
Check No. 16660